

## REMARKS

### Introduction

The Office Action of September 12, 2003 is a non-final action that rejected claims 1-17. Claims 1-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,338,059 (Fields). Claims 16-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fields in view of U.S. Patent No. 5,701,473 (Braseth). Claims 1-2, 7-9, 11-14, and 16 have been amended and new claims 18 and 19 have been added. Applicant respectfully requests reconsideration of the claims in view of the following remarks.

### Rejections under 35 U.S.C. § 103

Fields relates to creating hyperlinks originating from linked and unlinked elements of a web page on a real time basis. Fields allows users "to create new links to preexisting pages and new pages . . . [and] the links are generally created at unlinked elements in the web page." *See* col. 3, lls. 5-8. After creating the links, the search is initiated and Fields repeatedly teaches that the results are returned in a new web page.

For example, "[i]n one preferred embodiment, the search results are placed in a new browser window . . ." *See* col. 3, lls. 29-31. "Responsive to the selection of text in the web page, . . . the results [are] presented in a new web page." *See* col. 5, lls. 17-20. "In step 111, the results of the search operation are presented in a new web page to the user." *See* col. 6, lls. 28-30. In each of these examples, Fields teaches generating a search using text on a web page and returning the results in a new web page to the user. As a consequence, only one application (the web browser) is being used. In addition, a second window that the user can view is presented to the user. Thus, the user is apparently required to switch from the old window to the new

window and as a result, the search results are not returned within a context of the initial web page, but are returned in a new web page.

In contrast, claim 1 requires selecting one or more search terms within a first application. Next, claim 1 activates the one or more search terms within the first application. Then, claim 1 performs a search based on the one or more search terms with a second application such that the user remains in a context of the first application and does not view the second application. In Fields, two separate web page windows are generated whereas claim 1 returns results within a context of the first application.

One advantage of returning the search results to the first application is that the user is not required to switch between two separate windows, as indicated by Fields. In other words, Fields does not teach the ability to incorporate the results displayed in the new web page into the link created in the first page. In fact, Fields appears to teach away from claim 1 by presenting the results in a new window rather than in a context of the first application as required by claim 1.

The Office Action further states that Fields does not explicitly disclose that the user is not required to open another application. More particularly, the Office Action further suggests that the user can select one search engine, which teaches that once one search button is selected, the other are disabled. The Office Action concludes that it would have been obvious to a person having ordinary skill in the art the time the invention was made to include the user is not required to open another application in view of selecting one search engine. Applicants respectfully disagree for the following reasons.

As noted in Fields, a search engine may include "CNN, Yahoo, AltaVista, and Amazon web sites." *See* col. 5, lls. 57-58. Search terms are usually provided to a search engine from a computer and thus the search engine is not an application at the computer. Rather, the search

engine is an application at a remote server that is accessed, for example, over a network. Claim 1 requires that the first application is "at the computer" and that the second application is "at the computer." Thus, search engines such as CNN, Yahoo, AltaVista and Amazon are not an application "at the computer." In addition, claim 1 requires that "the computer remains in a context of the first application and does not display the second application to a user." Fields teaches that the user views a new web page as discussed above and not within the first application as required by claim 1.

For at least these reasons, claim 1 as amended is not taught by Fields and is believed to be in condition for allowance. Claim 11 has been amended to overcome the cited art for at least the same reasons. The dependent claims 2-10, and 12-15 depend from independent claims 1 and 11, respectfully, and overcome the cited art for at least this reason.

Claim 16-17 was rejected under 35 U.S.C. § 103(a) over Fields in view of Braseth. The Examiner states that Fields discloses previewing data within at least one application and cited Fig. 5 and Fig 1B. Claim 16 has been amended to require "previewing data that has not been selected by a user." Claim 16 further requires performing a search based on the portion of the previewed data. However, the portion of the previewed data was selected without user input.

Fields, in contrast, teaches that the pop up menu in Figure 1B appears because the user has selected text in the web page. *See* Fig. 1B. Figure 5 further confirms this teaching and is scanning text for a selection by a user (see 101). Figure 5 does not display search engines selections (105) until meaningful text is selected (103) by a user. More specifically in Fields, step 101 "is continually performed by the browser as it scans the text for a selection event which indicates that the user wants to invoke the mechanism of the present invention." *See* col. 5, ll. 5

35-39. Thus, user input is required by Fields, whereas claim 1 as amended selects a portion of the previewed data as search terms without user input.

The Examiner further cites Braseth as disclosing a search without input data. However, Braseth is directed to storage of data files for enhanced query processing performance. *See* col. 1, lls. 20-22. Braseth addresses problems related to the needs of businesses to analyze information in their day-to-day operations. Baseth mentions, for example, transaction databases such as associated with airlines, and the like.

In Braseth, a particular request for access to a database will be classified as either a "transaction" or a "query." *See* col. 1, lls. 45-48. These types of queries are initiated by users who are looking for specific information. Thus a query in the context of Braseth is generated by a user that is looking for specific information. For example, Braseth provides a query of "a request for all passengers who have specified vegetarian meals within the past year." *See* col. 1, lls. 49-52. Thus, Braseth teaches that queries or transactions correspond to specific requests. The discussion in Baseth mentioned in the Office Action (col. 3, lls. 43-63) discuss processing transactions and queries with two processors. As illustrated, however, the queries correspond to specific user requests. A query of Braseth is not, as required by claim 16, a search based on the portion of previewed data selected as search terms without user input.

For at least these reasons, claim 16 overcomes the cited art and is believed to be in condition for allowance. Claim 17 depends from claim 16 and is in condition for at least this reason.

New claims 18 is also believed to overcome the art of Fields and Braseth for at least the reasons discussed above. New claim 19 requires a selection of search data in a non-browsing

application and is not taught or suggested by Fields, which requires selecting text in a web page.

New claim 19 is also believed to overcome the cited art for the other reasons discussed above.

Applicant respectfully notes that the above discussion should not be construed to constitute an exhaustive enumeration of the distinctions between the claims of the present application and the references cited by the Examiner. Instead, such distinctions are presented solely by way of example. Applicant notes further that the arguments presented herein have been made merely to clarify the claimed invention from elements purported by the Examiner to be disclosed by the cited prior art references. Such arguments should not, however, be construed as an acquiescence on the part of the Applicant as to the purported teachings or prior art status of any of the cited references, nor as to the characterization of the cited references advanced by the Examiner. Accordingly, Applicant reserves the right to challenge the purported teaching and prior art status of any and all of the cited references at any appropriate time.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 12<sup>th</sup> day of February 2004.

Respectfully submitted,



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